



1756

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Kunio SAKURAI et al.

Group Art Unit: 1756

Application No.: 10/669,728

Examiner: M. Chapman

Filed: September 25, 2003

Docket No.: 117310

For: INFORMATION RECORDING MEDIUM AND METHOD OF PRODUCING SAME

REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the May 31, 2005 Office Action, reconsideration of the rejection is respectfully requested in light of the following remarks. Claims 1-16 are pending in this application.

I. Rejections Under 35 U.S.C. §103(a)

A. Torikoshi

Claims 1-16 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over U.S. Patent Publication No 2002-0182520 ("Torikoshi"). This rejection is respectfully traversed.

The Patent Office alleges that Torikoshi teaches a similar electrophotographic laminated film with the same surface resistance, and that it would have been obvious to have used the similar electrophotographic film because of the expectation of similar results. Applicants submit that such reasoning has not established a prima facie case of obviousness.

To establish a prima facie case of obviousness, three factors must be met: (1) there must be some suggestion or motivation to modify the prior art, (2) there must be a reasonable expectation of success with such modification, and (3) the prior art reference or references must teach or suggest all of the claim limitations. See MPEP §§ 706.02(j) and 2143.

Claim 1 recites an information recording medium comprising at least one electrophotographic laminate film and an opaque core base material. Similarly, claim 13 recites a method of producing an information recording medium comprising transferring a toner image to a transparent electrophotographic laminate film and then laminating a surface of the electrophotographic film, on which surface the toner image is formed, with an opaque core base material.

In contrast, Torikoshi teaches an image recording material on which an image can be formed by electrophotography. See the Abstract of Torikoshi. Nowhere does Torikoshi teach or suggest that an opaque core base material is then laminated onto the surface of the image recording material as required in claims 1-16.

The Patent Office has not introduced prior art reference(s) that teach or suggest all of the claim limitations. Similarly, the Patent Office has not indicated any motivation or suggestion to laminate the opaque core base material onto the electrophotographic laminate film as required in claims 1 and 13. Thus, Applicants submit the Patent Office has not established a prima facie case of obviousness.

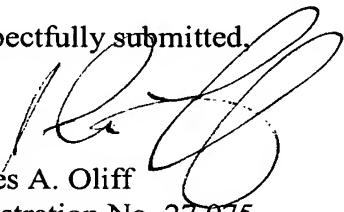
For the foregoing reasons, Applicants submit that claims 1-16 are patentable over Torikoshi. Reconsideration and withdrawal of the rejection are thus respectfully requested.

B. Matsuo in view of Ohishi and Ikeuchi

Claims 1-18 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 5,731,116 ("Matsuo") in view of U.S. Patent No. 6,656,649 ("Ohishi") and U.S. Patent No. 6,524,760 ("Ikeuchi"). This rejection is respectfully.

Thus, withdrawal of the Election of Species Requirement is respectfully requested.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

/John W. Fitzpatrick
Registration No. 41,018

JAO:JWF/ldg

Date: August 30, 2005

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p>
--

Applicants initially point out that claims 1-16 are pending herein, not claims 1-18 as indicated in the statement of rejection in the Office Action.

The Patent Office alleges that Matsuo teaches a laminated electrophotographic information recording medium where specific resins are used and specific surface resistance is observed. The Patent Office admits that Matsuo does not specifically teach the claimed range of the surface resistance. As such, the Patent Office has introduced Ohishi and Ikeuchi as allegedly teaching similar electrophotographic information recording mediums where the claimed range of the surface resistance is taught. Applicants respectfully disagree with the Patent Office's allegations.

Matsuo teaches an electrostatic information recording medium in which a charge retaining layer has high insulating properties. See the Abstract of Matsuo. Further, the electrostatic information recording medium is to record the information on the electric charge retaining layer as the distribution of electrostatic charge. The electrostatic information recording medium may take various forms according to the information to be recorded. For example, when it is used for an electrostatic camera, it takes the form of normal film or disk. When digital information or analog information is recorded by laser or the like, it takes the form of a tape, disk or card. See column 16, lines 43-52 of Matsuo. In other words, the information recording medium as taught by Matsuo is adapted to the storing of electronic data information, not the printing of information.

Matsuo does not teach or suggest an information recording medium having at least one electrophotographic laminate film on which a toner image is formed as recited in claims 1 and 13.

In contrast, both Ohishi and Ikeuchi teach image recording mediums that fix toner images. This vastly differs from Matsuo's teachings of a recording medium that is adapted for the storage of electronic data information. Accordingly, Applicants submit that one of

ordinary skill in the art would not have combined the teachings of Matsuo with the teachings of Ohishi and Ikeuchi as the image recording mediums are vastly different. One would not have looked to the very different fields of Ohishi and Ikeuchi for any teachings relevant to the data storage device of Matsuo.

Moreover, even if Matsuo, Ohishi and Ikeuchi were combined, the information recording medium and the method of producing it would not have been achieved. None of the references, alone or in combination, teach or suggest that an opaque core base material is laminated on a surface of the electrophotographic laminate film, on which surface the toner image is formed, as required in claims 1 and 13.

For the foregoing reasons, Applicants submit that claims 1-16 are patentable over Matsuo, Ohishi and/or Ikeuchi. Reconsideration and withdrawal of the rejection are thus respectfully requested.

II. Obviousness-Type Double Patenting Rejection

Claims 1-16 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-18 of copending Application No. 10/624,689 ("Application '689"). Applicants respectfully disagree.

Similar to Torikoshi, the claims of Application '689 do not teach or suggest an opaque core base material laminated on the electrophotographic laminate film as recited in claims 1-16. Similar to Torikoshi, the Patent Office has not established a prima facie case of obviousness. As such, Applicants submit that present claims 1-16 are patentably distinct from claims 1-18 of Application '689.

Reconsideration and withdrawal of the rejection are thus respectfully requested.

III. Information Disclosure Statement

As discussed in a telephone conference on June 20, 2005 between Examiner Chapman and Applicants' representative, attached to the Office Action mailed on May 31 was a Form PTO-1449 from an Information Disclosure Statement ("IDS") not belonging to the present application. The IDS and Form PTO-1449 belong to Application No. 10/663,728. As such, Applicants respectfully request removal of this erroneous IDS and PTO Form-1449 from the file wrapper of the present application.

IV. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-16 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

Leana Levin

James A. Oliff
Registration No. 27,075

Leana Levin
Registration No. 51,939

JAO:LL/hs

Date: August 30, 2005

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p>
--